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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,570	09/27/2001	Toshiya Kai	NPR-085	8923

20374 7590 03/31/2004  
KUBOVCIK & KUBOVCIK  
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WASHINGTON, DC 20006

EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT PAPER NUMBER

1616

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/963,570

Applicant(s)

KAI ET AL.

Examiner

Sharmila S. Gollamudi

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1, 4, 7-9, 11, 13-14.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Applicant argues that EP '918 does not teach a first composition with the instant size and the second composition with the instant particle size. Applicant argues that glucose has a particle diameter of 180 microns and not instant particle size. Therefore, a homogenous mixture is not produced. The applicant argues that example 2 does not teach glucose. Lastly, applicant argues that EP does not teach the process of making the composition as claimed in claims 8-9.

Applicant's arguments have been fully considered but they are not persuasive. Firstly, the examiner points out that applicant claims that instant invention yields a homogenous mixture because both compositions have the same particle size. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In instant composition, applicant only claims the same particle range of 300 to 1700 microns for both compositions but does not claim that the both compositions have to have the same particle size, i.e. the first composition having 300 microns and the second also having 300 microns.

Secondly, the examiner points out to page 6 for the average particle size of 10-200 mesh and the preferable range of 14-100 mesh for the first composition. This correlates to 2mm (2000 microns) to 75 microns and 1.4mm (1400 microns) to 150 microns which in instant range. Page 7 teaches the average particle size of 10 to 100

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mesh and the preferable range of 12 to 100 mesh for the second composition. This correlates to 2mm (2000 microns) to 150 microns and 1.7mm (1700 microns) to 150 microns which in instant range.

The claim language is open and does not exclude the an additional coating (sodium bicarbonate) for the glucose particles. Secondly, it is pointed out that the dependent claim 7 requires sodium bicarbonate in the product.

In regards to example 2 does not teaching glucose, the examiner points out that the example pertains to the first composition and instant first composition does not have glucose either.

Lastly in regards to claims 8 and 9, it should be noted that the arguments regarding these claims, are confusing. The examiner points out that the claims are product-by-process wherein patentability is based on the product itself and not the process in which it is made, thus the step of spraying is not given weight. Note MPEP section 2113, "even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir. 1985). Again, it is pointed out that claims 8-9 do not exclude sodium bicarbonate and thus are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-

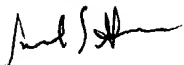
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242-0614. The examiner can normally be reached on M-F (8:00-5:00) with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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